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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,402	02/10/2004	Craig M. Housworth	P0008939.04	8871

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MEDTRONIC, INC.
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EXAMINER

SCHAETZLE, KENNEDY

ART UNIT	PAPER NUMBER
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3766

MAIL DATE	DELIVERY MODE
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09/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,402

Applicant(s)

HOUSWORTH ET AL.

Examiner

Kennedy Schaetzle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 18, 2007 has been entered.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

CORRECT STATEMENT should read "I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

INCORRECT STATEMENTS: "I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations Section 1.56(a)"

"I acknowledge the duty to disclose information which is material to the patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56(a)"

"I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations Section 1.56"

Specification

3. The disclosure is objected to because of the following informalities: the status of the CIP application mentioned on page 1 must be updated.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-3, 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear if the user interface recited on line 3 is intended to be associated with the module or the clinical instrument. The examiner suggests inserting "said module" or "said clinical instrument" prior to the word "having" on line 3 in order to eliminate any ambiguity. Based on claim 8, it is assumed that the applicant is referring to the clinical instrument.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3, 5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Snell (Pat. No. 6,263,245).

Regarding claim 1, Snell discloses a module 110/230 adapted for use with a clinical instrument 150/240 having a user interface (the keyboard interface 170 of the programmer unit) to provide at least a subset of programmer functionality for an implantable medical device, the module comprising: a telemetry circuit (400, 440, etc.) for telemetric communication with an implantable medical device 120 to interrogate the implantable medical device in retrieval of data;
a connector (see the area generally referenced by the dotted line in Fig. 2 and the

communications interface of Fig. 3) adapted to be electrically coupled to the clinical instrument; and means for coordinating real-time communication (420, 440) between the telemetry circuit and the clinical instrument user interface.

Since real-time communication includes transmission of user interrogation requests to upload or download information, the system of Snell provides such capability (see col. 8, lines 21-43).

The limitations of claim 3 are clearly anticipated.

Regarding claim 5, the applicant is not claiming a clinical instrument, merely a module adapted for use with a clinical instrument. Clearly as the module of Snell is adapted for use with a programmer/monitor, it would be adapted for use with the same monitor located bedside.

Again, regarding claim 8, the applicant is not claiming the clinical instrument. Limitations concerning the type of display for a non-element of the invention fail to limit the structure of the module. In any event, those of ordinary skill in the art would have considered the clinical instrument shown in Fig. 2 to show a printer on the left side of the device's display screen.

Claim Rejections - 35 USC § 102/103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Snell.

Regarding claim 2, the examiner considers the requisite power source in unit 100 to be connected to the portable unit 110 when the two units are engaged by virtue of the mechanical connection of one housing to the other. In any event, the examiner took Official Notice in a previous Office Action that connection systems such as USB and Firewire (note col. 6, lines 53-60) allow for plug-in peripheral devices to be powered

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and/or recharged by primary units that typically plug into a buildings electrical power system at the wall outlet. Such arrangements allow for convenient recharging and/or conserve the portable device's battery power when reliance on autonomous power is unnecessary. As this notice had not been traversed, the feature or limitation was considered admitted prior art.

Response to Arguments

10. Applicant's arguments filed July 18, 2007 have been fully considered but they are not persuasive.

As stated above, since real-time communication includes transmission of user interrogation requests to upload or download information, the system of Snell provides such capability. Furthermore, artisans of ordinary skill in the art would have realized from the disclosure of Snell and from commonly available knowledge that real-time transmission of measured data, while perhaps more limiting and inconvenient in certain situations, would have been an available option if conditions required instant access to newly measured data to allow for on-the-spot interpretation (such as when the patient is under examination in a doctor's office and tests are performed to ascertain the effectiveness of the implant). The substitution of one known element for another known element to obtain predictable results has been considered by the courts to be obvious.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 571 272-4954. The examiner can normally be reached on M-F from 9:30 -6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on M-F at 571 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KJS

September 21, 2007



KENNEDY SCHAETZLE
PRIMARY EXAMINER